

REMARKS

Initially, Applicants have amended claims 169, 194, 255, 281-283, 290-297, 299-300, and 302 to more accurately claim the present invention and not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments overcome the rejections set forth in the February 28, 2003 Office Action and that the rejections should be withdrawn.

10 I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed book having at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, these machine recognizable features are scanned or sensed and converted into an electronic signal, which is transmitted to be processed. The processing results in the display of programming material related to the information contained in the printed book. Importantly, the present invention is designed to allow a user to access programming material related to the

information contained in the printed book to supplement the information provided by the printed book.

II. THE EXAMINER'S REJECTIONS

5 The Examiner rejected claims 168-169 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") and knowledge commonly known in the art. The Examiner argued that Withnall teaches the use of a battery
10 powered handset having a bar code reading means, a microprocessor, a keypad, and a display. The Examiner admitted, however, that "[t]he claim[s] differ[] [from Withnall] in calling for a printed book." (February 28, 2003 Office Action Summary, p. 4). The Examiner then
15 opined that utilizing Withnall's teachings with a printed book, "such as a ticket book," would have been obvious.

 Also, the Examiner rejected claims 170-194, 298, and 301 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art
20 of record" including Thacher et al. U.S. Patent No. 5,083,271 (hereinafter referred to as "Thacher"); Ertz et al. U.S. Patent No. 5,003,577 (hereinafter referred to as "Ertz"); and Plummer U.S. Patent No. 4,992,824 (hereinafter referred to as "Plummer"). The Examiner contended that

replacing the data link of Withnall with any other data link would have been obvious. The Examiner specifically pointed out the data links of Thacher, Ertz, and Plummer, which include local area networks, cable television 5 ("CATV") links, telephone line videotext channels, voice links, and integrated services digital networks ("ISDN") and other data links to transmit image and video information.

Additionally, the Examiner rejected claims 195-219, 10 299, and 302 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art of record" including Konishi et al. U.S. Patent No. 5,237,156 (hereinafter referred to as "Konishi") and Younger U.S. Patent No. 5,151,687 (hereinafter referred to 15 as "Younger"). The Examiner admitted that Withnall fails to teach codes other than bar codes such as watermarks, invisible bar codes, magnetic codes, printed characters, invisible icons, etc. The Examiner took Official Notice that the use of these features was known. The Examiner 20 then stated that interchanging input sources would have been a design choice and that Konishi and Younger display evidence of interchanging differing types of media. Konishi is cited for disclosing the scanning of bar codes and magnetic characters and optical character recognition

("OCR"). Younger is cited for teaching methods of identifying taped material such as words, mnemonics, numeric codes, abbreviations, symbols, and icons.

Next, the Examiner rejected claims 220-265 under 35 U.S.C. § 103(a) as being unpatentable over Withnall. The Examiner admitted that:

"[t]he claims differ [from Withnall] in calling for the step of encoding individual information, background check information, service information, etc. in a machine recognizable indica [sic]. Since the content of the code and printed matters could be arbitrary, it would have been obvious to encode/include such features in the teachings as taught by Withmall [sic]. The claims also differ in calling for the use of prose, organization reference[s], Web page[s], etc. It is further submitted that a Court has decided that printed matter such as encoding particular information in a code, etc., would not be given patentable weight (In re Gulack, 217, U.S.P.Q. 401)." (February 28, 2003 Office Action Summary, pp. 6-7).

Then, the Examiner rejected claims 262-280 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view

of Ishii et al. U.S. Patent No. 5,148,297 (hereinafter referred to as "Ishii"). The Examiner admitted that "[t]he claims differ [from Withnall] in calling for the use of various type[s] of display device[s]." (February 28, 2003 Office Action Summary, p. 7) The Examiner then took Official Notice that the use of televisions, pagers, laptops, computers, telephones, and books for displaying messages was known. Ishii is specifically cited for disclosing a liquid crystal display ("LCD") adaptable for televisions, games, laptops, etc.

Also, the Examiner rejected claims 281-296 under U.S.C. § 103(a) as being unpatentable over Withnall. The Examiner admitted that "[t]he claims differ [from Withnall] in calling for the use of various type[s] of code recognition device[s]." (February 28, 2003 Office Action Summary, p. 8). The Examiner then took Official Notice that the use of scanners, digital mice, digital cameras, optical readers, computers, and televisions was known.

20 III. **THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

The Examiner rejected claims 163-169 under 35 U.S.C. § 103(a) as being unpatentable over Withnall. In a subsequent rejection, the Examiner rejected claims 220-265 under 35 U.S.C. § 103(a) also as being unpatentable over

Withnall. In another rejection, the Examiner rejected claims 281-296 under 35 U.S.C. § 103(a) once again as being unpatentable over Withnall. Applicants respectfully disagree with the aforementioned rejections. Withnall
5 specifically discloses a system for easing the examination of commuter tickets for validity. The system is designed to read a bar code from a ticket to determine the validity of the ticket. This system is far removed from the claimed invention. Claims 168, 297, and 300 teach a system or
10 method which accesses programming material as a result of recognition of a machine recognizable feature in a printed book. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the
15 most recently updated version of the associated information (or programming material) upon scanning a textbook. This is not possible with Withnall. First of all, Withnall fails to disclose any programming material. Withnall only returns a validity state of a ticket, and not more
20 substantial programming material which includes information that supplements the information in the printed book. Even if Withnall does disclose programming material (although Withnall does not), the system would be unable to provide the updateable programming material of the present

invention. Any database of validity states of Withnall is stored locally on a vehicle (e.g., a bus). If the database needed to be updated, the information must be altered on the vehicle. Withnall does disclose a "radio data link" for transmitting validity information. However, this radio data link could not successfully transmit programming material. The radio data link of Withnall is designed only to transmit validity states. The programming material of the present invention (e.g., audio or visual material), on the other hand, would require substantially more data to be transmitted in a specialized format. The radio data link of Withnall is obviously not designed to do this, and therefore, an inventive step must be performed to allow the system of Withnall to transmit programming material to or from a vehicle.

Additionally, the Examiner contended that the printed book of the claimed invention would be an obvious substitution for a ticket of Withnall. Applicants respectfully disagree because Withnall's system is specifically designed for ticketing systems. Therefore, one could not automatically arrive at the idea of utilizing the system for accessing programming material related to a printed book because Withnall intently teaches that the patented system be used for commuter ticketing systems. As

to the Examiner's comparison of a printed book to a ticket book, Applicants submit that the printed book of the claims is intended to provide printed information, such as text and pictures, and not merely tickets, printed or otherwise.

5 In view of the foregoing, independent claims 168, 297, and 300 cannot be unpatentable over Withnall. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore, these claims are also not unpatentable
10 over Withnall.

 In all subsequent rejections, the Examiner noted the deficiencies of Withnall regarding matter disclosed in dependent claims and appended various other references including Thacher, Ertz, Plummer, Konishi, Younger, and
15 Ishii to Withnall in order to provide the additional features of the dependent claims. However, the pending claims have been shown to not be unpatentable over Withnall. Because Withnall is relied upon by the Examiner to disclose features which Applicants have demonstrated not
20 to be contained within or obvious in light of Withnall's teachings, combining additional references to Withnall to cover additional features would still be insufficient for rejecting any claims under 35 U.S.C. § 103. Thus,

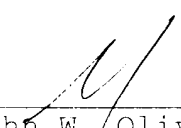
Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: 6-23-2003



John W. Olivo, Jr.
Reg. No. 35,634
Ward & Olivo
382 Springfield Ave.
Summit, NJ 07901
908-277-3333